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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,184	11/17/2003	George W. Muller	501872-999056	3369
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JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017				
EXAMINER GRAFFEO, MICHEL				
ART UNIT		PAPER NUMBER		
1614				
DATE MAILED: 11/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/715,184

**Applicant(s)**

MULLER ET AL.

**Examiner**

Michel Graffeo

**Art Unit**

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-19 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19 and 24-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10 May 06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Action***

Claims 17-19 and 24-32 are examined.

Applicant has amended claims 17, 24 and 29-31 and provided arguments for the patentability of claims 17-19 and 24-32 in the response filed 10 May 2006.

Applicant's arguments, see response, filed 10 May 2006, have been fully considered but are persuasive only to the extent that the scope of the rejection under 35 U.S.C. 112 has been modified. Any rejection not specifically stated in this Office Action has been withdrawn.

### ***Claim Rejections - 35 USC § 112 1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

This rejection is modified to the extent of the scope of the rejection. Claims 17-19 and 24-32 are rejected under 35 U.S.C. 112, first paragraph, because the specification is not enabling for a method of treating a disease ameliorated by the inhibition of PDE4. In other words, the specification does not enable any person skilled

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in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

In this regard, the application disclosure and claims have been compared per the factors indicated in the decision *In re Wands*, 8 USPQ2nd 1400 (Fed. Cir. 1988) as to undue experimentation.

The factors include:

- 1) the nature of the invention;
- 2) the breadth of the claims;
- 3) the predictability or unpredictability of the art;
- 4) the amount of direction or guidance presented;
- 5) the presence or absence of working examples;
- 6) the quantity of experimentation necessary;
- 7) the state of the prior art; and ,
- 8) the relative skill of those skilled in the art.

Each factor is addressed below on the basis of comparison of the disclosure, the claims and the state of the art in the assessment of undue experimentation.

- 1) the nature of the invention; the invention is directed to a method for treating diseases associated with increased PDE4 and as recited, e.g., in claim 19 a laundry list of disease(s)/condition(s)..
- 2) the breadth of the claims; the scope of the method claims includes the treatment and prevention of a list of a long list of disorders such as asthma, inflammation, AIDS and graft rejection.
- 3) the predictability or unpredictability of the art; the compounds of the instant claims are not recited in the prior art and consequently there is are no

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disclosures which would enable one of ordinary skill in the art to identify patients, predict dosages and routes of administration for example in each case wherein the compound are to be used for such a broad possibility of indications especially where as here, there is no indication of any commonality of mechanism of action for the recited drug in the claimed diseases/conditions. None of the examples either single or collectively demonstrate each of the treatments as successful.

4) the amount of direction or guidance presented; the specification does not provide any guidance in terms treating any/all claimed diseases associated with increased PDE4. Therefore, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling. See, e.g., *Chiron Corp. v. Genentech Inc.*, 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1326 (Fed. Cir. 2004) ("Nascent technology, however, must be enabled with a specific and useful teaching." The law requires an enabling disclosure for nascent technology because a person of ordinary skill in the art has little or no knowledge independent from the patentee's instruction. Thus, the public's end of the bargain struck by the patent system is a full enabling disclosure of the claimed technology." And, in this case, since the compounds are novel, there is a lack of predicability. The "predictability or lack thereof" in the art refers to the ability of one skilled in the art to extrapolate the disclosed or known results to the claimed invention. If one skilled in the art can readily anticipate the effect of a change within the subject matter to which the claimed invention pertains, then there is

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predictability in the art. On the other hand, if one skilled in the art cannot readily anticipate the effect of a change within the subject matter to which that claimed invention pertains, then there is lack of predictability in the art. Accordingly, what is known in the art provides evidence as to the question of predictability.

The scope of the required enablement varies inversely with the degree of predictability involved, but even in unpredictable arts, a disclosure of every operable species is not required. A single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements. In *re Vickers*, 141 F.2d 522, 526-27, 61 USPQ 122, 127 (CCPA 1944); In *re Cook*, 439 F.2d 730, 734, 169 USPQ 298, 301 (CCPA 1971). However, in applications directed to inventions in arts where the results are unpredictable, the disclosure of a single species usually does not provide an adequate basis to support generic claims. In *re Soll*, 97 F.2d 623, 624, 38 USPQ 189, 191 (CCPA 1938). In cases involving unpredictable factors, such as most chemical reactions and physiological activity, more may be required. In *re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (contrasting mechanical and electrical elements with chemical reactions and physiological activity). See also In *re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); In *re Vaeck*, 947 F.2d 488, 496, 20 USPQ2d 1438, 1445 (Fed. Cir. 1991). As noted above, the unpredictability in the pharmaceutical arts regarding dosing, patient sensitivities and modes of administration for

example necessitates further support for enabling the treatment of diseases associated with increased PDE4.

5) the presence or absence of working examples; no working examples are provided in the specification which would show that a representative number of indications were treated. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

6) the quantity of experimentation necessary; the quantity of experimentation would be an undue burden to one of ordinary skill in the art and amount to the trial and error type of experimentation. Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention and unpredictability of preventing asthma, inflammation etc., and the lack of working examples regarding the activity as claimed, one skilled in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

None of the data in the specification appear to demonstrate a nexus of administration of the compounds/compositions to any amelioration or prevention of any of the recited diseases or conditions recited in the claims. It is also not apparent from

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the specification that there is a nexus of PDE4 to a particular common mechanism of action for each of the claimed and/or disclosed disease state(s) and/or condition(s).

In consideration of each of factors 1-8, it is apparent that there is undue experimentation because of variability in prediction of outcome that is not addressed by the present application disclosure, examples, teaching and guidance presented. Absent factual data to the contrary, the amount and level of experimentation needed is undue.

### ***Response to Arguments***

Applicant's arguments filed 10 May 2006 have been fully considered but they are not persuasive. Applicant argues that the claims are enabled for the treatment of the diseases listed in claim 19 for example, but only provides evidence of enablement for the treatment of respiratory diseases and inflammation. Diseases such as malaria, HIV and Parkinson's for example are not enabled particularly in light of the lack of prior art related to the claimed compound.

### ***Conclusion***

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michel Graffeo whose telephone number is 571-272-8505. The examiner can normally be reached on 9am to 5:30pm Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5 November 2006  
MG

*Ardin H. Marschel 11/12/06*  
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SUPERVISORY PATENT EXAMINER